



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,724	12/06/2001	Michael L. Maritzen	80398.P666	8876

7590 03/09/2007
Sheryl Sue Holloway
Blakely, Sokoloff, Taylor, & Zafman LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER

OSBORNE, MATTHEW C

ART UNIT	PAPER NUMBER
----------	--------------

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/015,724	Applicant(s) MARITZEN ET AL.	
	Examiner Matthew Osborne	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-74, 87-94, 112-119, 125, 126, 128, 134, 135 and 137 is/are pending in the application.
- 4a) Of the above claim(s) 1-58, 75-86, 95-111, 120-124, 127, 129-133 and 136 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-74, 87-94, 112-119, 125, 126, 128, 134, 135 and 137 is/are rejected.
- 7) ☒ Claim(s) 59, 68, 87, 94, 112 and 125 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the Applicant's Reply dated 2/8/2007 concerning Application 10/015724.

Claims 59-74, 87-94, 112-119, 125-126, 128, 134-135, and 137 have been examined.

Election/Restrictions

1. Claims 1-58, 75-86, 95-111, 120-124, 127, 129-133, and 136 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/8/2007.

Claim Objections

2. Claims 59, 68, 87, 94, 112, and 125 are objected to because of the following informalities: Re Claims 59 and 112, typo in "key0enabled" which should read "key-enabled." Re Claim 68, typo in "persona transaction device" should read "personal transaction device." Re Claim 87, typo in "loading the PRD" should read "loading the PTD." Re Claim 94, typo in "is selected form the group" should read "is selected from the group." Re Claim 125, typo at the end of second "means" statement, statement should end with ";". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3694

4. Claim 119 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 119 recites the limitation "the appropriate enabling authority" in Line 1. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, the limitation will be construed to read "said PTD further being associated with a third party enabling authority, said third party enabling authority...."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 59-62, 65-73, 112-118, 125-126 and 134-135 are rejected under 35 U.S.C. 102(b) as being anticipated by Gunnarsson (5,862,222).

7. Re Claim 59, Gunnarsson discloses a system at a vehicle for debiting at automatic fuelling comprising:

- loading a pre-registered, key-enabled, personal transaction device (PTD) with a pre-funded cash account; (see at least Column 3, Lines 56-62, wherein the PTD is the device disclosed in Figure 1, Item 5, and described throughout)
- establishing communication between a vehicle-accessed, payment-gateway terminal (VAPGT) and the PTD; (see at least Column 5, Lines 5-30)

Art Unit: 3694

- accessing the PTD using a privacy card; and (see at least Column 2, Lines 18-37)
- deducting a transaction amount from the pre-funded cash account to complete the transaction. (see at least Column 3, Lines 48-55)

8. Re Claims 60-62 and 65-67, Gunnarsson discloses all of the limitations of Parent Claim 59, further comprising:

- [Claim 60] wherein the privacy card is a biometric control device. (see at least Column 2, Lines 28-37)
- [Claim 61] initiating communication with the VAPGT by the PTD. (see at least embodiment described in Column 5, Lines 9-13)
- [Claim 62] initiating communication with the PTD by the VAPGT. (see at least embodiment described in Column 5, Lines 23-30)
- [Claim 63] registering the PTD with an appropriate enabling authority, the PTD is associated with a particular user. (see at least Column 1, Line 64, through Column 2, Line 2, wherein the registration with the company providing the service and system inherently occurs in order for the "registration unit" and biometric or PIN identification to work as described therein)
- [Claim 65] wherein the PTD and VAPGT communicate via a wireless connection. (see at least Column 1, Lines 61-62)
- [Claim 66] wherein the PTD is a PKI-enabled PTD. (see at least Column 3, Lines 13-30)

Art Unit: 3694

- [Claim 67] wherein the VAPGT is selected from the group consisting of a tollbooth, a vehicular kiosk, a ticket booth, and a smog certification station. (see at least Figure 1, Item 2: a vehicular kiosk)

9. Re Claim 68, Gunnarsson discloses a system at a vehicle for debiting at automatic fuelling comprising:

- establishing communication between a pre-registered, key-enabled, personal transaction device (PTD) including a pre-loaded, pre-funded cash account and a vehicle-accessed, payment-gateway terminal (VAPGT); and (see at least Column 5, Lines 5-30)
- receiving a transaction authorization message from the PTD to complete the transaction. (see at least Column 3, Lines 31-55, wherein the authorization message is the sending of a PIN or biometric identification signal)

10. Re Claims 69-73, Gunnarsson discloses all of the limitations of Parent Claim 68, further comprising:

- [Claim 69] initiating communication with the VAPGT by the PTD. (see at least embodiment described in Column 5, Lines 9-13)
- [Claim 70] initiating communication with the PTD by the VAPGT. (see at least embodiment described in Column 5, Lines 23-30)
- [Claim 71] wherein the PTD and VAPGT communicate via a wireless connection. (see at least Column 1, Lines 61-62)
- [Claim 72] wherein the PTD is a PKI-enabled PTD. (see at least Column 3, Lines 13-30)

Art Unit: 3694

- [Claim 73] wherein the VAPGT is selected from the group consisting of a tollbooth, a vehicular kiosk, a ticket booth, and a smog certification station. (see at least Figure 1, Item 2: a vehicular kiosk)

11. Re Claim 112, Gunnarsson discloses a system at a vehicle for debiting at automatic fuelling comprising:

- a pre-registered, key-enabled, personal transaction device (PTD) (see at least Figure 1, Item 5) including a pre-loaded, pre-funded cash account; (see at least Column 3, Lines 56-62)
- a vehicle-accessed, payment-gateway terminal (VAPGT) in proximity to the PTD; (see at least Figure 1, Item 2)
- a privacy card connected to the PTD used to access the PTD (see at least Figure 1, Items 11 and/or 8, connected wirelessly to PTD through the system for access of read/write data including pre-funded account therein), the PTD deducts a transaction amount from the pre-funded cash account and sends a transaction authorization message to the VAPGT to complete the transaction. (see at least Column 3, Lines 31-55)

12. Re Claims 113-118, Gunnarsson discloses all of the limitations of Parent Claim 112, further comprising:

- [Claim 113] wherein the privacy card is a biometric control device. (see at least Column 2, Lines 28-37)
- [Claim 114] wherein the PTD initiates communication with the VAPGT. (see at least embodiment described in Column 5, Lines 9-13)

Art Unit: 3694

- [Claim 115] wherein the VAPGT initiates communication with the PTD. (see at least embodiment described in Column 5, Lines 23-30)
- [Claim 116] wherein the PTD and VAPGT communicated via a wireless connection. (see at least Column 1, Lines 61-62)
- [Claim 117] wherein the PTD is a PKI-enabled PTD. (see at least Column 3, Lines 13-30)
- [Claim 118] wherein the VAPGT is selected from the group consisting of a tollbooth, a vehicular kiosk, a ticket booth, and a smog certification station. (see at least Figure 1, Item 2: a vehicular kiosk)

13. Re Claims 125 and 134, Gunnarsson discloses a system at a vehicle for debiting at automatic fuelling comprising:

- means for loading a pre-registered, key-enabled, personal transaction device (PTD) with a pre-funded cash account; (see at least Column 3, Lines 56-62)
- means for establishing communication between a vehicle-accessed, payment-gateway terminal (VAPGT) and the PTD; (see at least Column 5, Lines 5-30)
- means for accessing the PTD using a privacy card; and (see at least Column 2, Lines 18-37)
- means for deducting a transaction amount from the pre-funded cash account to complete the transaction. (see at least Column 3, Lines 48-55)

14. Re Claims 126 and 135, Gunnarsson discloses a system at a vehicle for debiting at automatic fuelling comprising:

Art Unit: 3694

- means for establishing communication between a pre-registered, key-enabled, personal transaction device (PTD) including a pre-loaded, pre-funded cash account and a vehicle-accessed, payment gateway terminal (VAPGT); and (see at least Column 5, Lines 5-30)
- means for receiving a transaction authorization message from the PTD to complete the transaction. (see at least Column 3, Lines 31-55, wherein the authorization message is the sending of a PIN or biometric identification signal)

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gunnarsson ('222) in view of Swett (5,101,200).

17. Re Claim 64, Gunnarsson teaches all of the limitations of Parent Claim 63, *supra*. Gunnarsson does not specifically disclose *wherein the appropriate enabling authority is selected from the group consisting of a financial institution, a third-party distributor, and a credit card issuer*. However, Swett teaches a "fast lane credit card" wherein "the instrument [PTD] is a functional authorized credit card/debit card which is issued by banks, or the Turnpike Authority, or a licensed agency" (see at least Column 20, Lines 12-14). Since both Gunnarsson and Swett relate to mobile devices used to pay for vehicular services and products, it would therefore be obvious to one of ordinary skill in

Art Unit: 3694

the art at the time of invention to incorporate the third party registration/payment linkage of Swett into the vehicular payment system of Gunnarsson in order to better "negotiate[] monetary funds transfer remotely, in real time, thus allowing toll transaction payments to be made from a moving vehicle without stopping or without slowing down" (see Swett, Column 20, Lines 5-9).

18. Claims 74, 87-93, 128, and 137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunnarsson ('222) in view of Sekine (5,204,675).

19. Re Claim 74, Gunnarsson teaches all of the limitations of Parent Claim 68, *supra*. Gunnarsson does not specifically disclose *if the transaction is not valid, notifying appropriate authorities of the invalid transaction, and disabling the PTD*. However, Sekine teaches a "toll collecting system for a vehicle" where "if ... the vehicle number data D1 and vehicle number data D2 are found not to be the same, vehicle 1 is interrupted by the closing of the gate GT to be stopped on the lane so that a toll collector may attend to the driver of the vehicle" and "if the radio card is identified as an unauthorized radio card, ... toll collector confiscates the radio card from the driver" (see at least Sekine, Column 4, Line 59, through Column 5, Line 11). Since both Gunnarsson and Sekine relate to mobile devices used to pay for vehicular services and products, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the fraud/invalid authorization message reactive steps of Sekine into the vehicular payment system of Gunnarsson for the system to be more "capable of accurate vehicle identification and preventing interference on data access" (see Sekine, Column 1, Lines 41-44).

Art Unit: 3694

20. Re Claims 87-93, Gunnarsson teaches a system at a vehicle for debiting at automatic fuelling comprising:

- [Claim 87] registering a key-enabled, personal transaction device (PTD) with an appropriate enabling authority, the PTD is uniquely identified with a particular user; (see at least Column 2, Line 63, through Column 3, Line 12)
- loading the PRD with a pre-funded cash account; (see at least Column 3, Lines 56-62)
- establishing communication between a vehicle-accessed, payment-gateway terminal (VAPGT) and the PTD; (see at least Column 5, Lines 5-30)
- accessing the PTD using a privacy card; (see at least Column 2, Lines 18-37)
- transmitting a transaction request to the PTD; (see at least Column 5, Line 62, through Column 6, Line 19)
- determining if the transaction is valid; (see at least Column 4, Lines 4-17)
- if the transaction is valid,
 - deducting a transaction amount from the pre-funded cash account, and (see at least Column 3, Lines 48-55)
 - transmitting a transaction authorization message to the VAPGT to complete the transaction; and (see at least Column 3, Lines 31-40)
- if the transaction is not valid,
 - transmitting an invalid transaction message to the VAPGT, (see at least Column 3, Lines 31-40, wherein the PIN or biometric verification is improper)

Art Unit: 3694

- [Claim 88] wherein the privacy card is a biometric control device. (see at least Column 2, Lines 28-37)
- [Claim 89] initiating communication with the VAPGT by the PTD. (see at least embodiment described in Column 5, Lines 9-13)
- [Claim 90] initiating communication with the PTD by the VAPGT. (see at least embodiment described in Column 5, Lines 23-30)
- [Claim 91] wherein the PTD and VAPGT communicate via a wireless connection. (see at least Column 1, Lines 61-62)
- [Claim 92] wherein the PTD is a PKI-enabled PTD. (see at least Column 3, Lines 13-30)
- [Claim 93] wherein the VAPGT is selected from the group consisting of a tollbooth, a vehicular kiosk, a ticket booth, and a smog certification station. (see at least Figure 1, Item 2: a vehicular kiosk)

Gunnarsson does not teach *notifying appropriate authorities of the invalid transaction and disabling the PTD*. However, Sekine teaches a "toll collecting system for a vehicle" where "if ... the vehicle number data D1 and vehicle number data D2 are found not to be the same, vehicle 1 is interrupted by the closing of the gate GT to be stopped on the lane so that a toll collector may attend to the driver of the vehicle" and "if the radio card is identified as an unauthorized radio card, ... toll collector confiscates the radio card from the driver" (see at least Sekine, Column 4, Line 59, through Column 5, Line 11). Since both Gunnarsson and Sekine relate to mobile devices used to pay for vehicular services and products, it would therefore be obvious to one of ordinary skill in

Art Unit: 3694

the art at the time of invention to incorporate the fraud/invalid authorization message reactive steps of Sekine into the vehicular payment system of Gunnarsson for the system to be more "capable of accurate vehicle identification and preventing interference on data access" (see Sekine, Column 1, Lines 41-44).

21. Re Claims 128 and 137, Gunnarsson teaches a system at a vehicle for debiting at automatic fuelling comprising:

- means for registering a key-enabled, personal transaction device (PTD) with a appropriate enabling authority, the PTD is uniquely identified with a particular user; (see at least Column 2, Line 63, through Column 3, Line 12)
- means for loading the PTD with a pre-funded cash account; (see at least Column 3, Lines 56-62)
- means for establishing communication between a vehicle-accessed, payment-gateway terminal (VAPGT) and the PTD; (see at least Column 5, Lines 5-30)
- means for accessing the PTD using a privacy card; (see at least Column 2, Lines 18-37)
- means for transmitting a transaction request to the PTD; (see at least Column 5, Line 62, through Column 6, Line 19)
- means for determining if the transaction is valid; (see at least Column 4, Lines 4-17)
- if the transaction is valid,
 - means for deducting a transaction amount from the pre-funded cash account, and (see at least Column 3, Lines 48-55)

Art Unit: 3694

- means for transmitting a transaction authorization message to the VAPGT to complete the transaction; and (see at least Column 3, Lines 31-40)
- if the transaction is not valid,
 - means for transmitting an invalid transaction message to the VAPGT, (see at least Column 3, Lines 31-40, wherein the PIN or biometric verification is improper)

Gunnarsson does not teach *means for notifying appropriate authorities of the invalid transaction* and *means for disabling the PTD*. However, Sekine teaches a “toll collecting system for a vehicle” where “if ... the vehicle number data D1 and vehicle number data D2 are found not to be the same, vehicle 1 is interrupted by the closing of the gate GT to be stopped on the lane so that a toll collector may attend to the driver of the vehicle” and “if the radio card is identified as an unauthorized radio card, ... toll collector confiscates the radio card from the driver” (see at least Sekine, Column 4, Line 59, through Column 5, Line 11). Since both Gunnarsson and Sekine relate to mobile devices used to pay for vehicular services and products, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the fraud/invalid authorization message reactive steps of Sekine into the vehicular payment system of Gunnarsson for the system to be more “capable of accurate vehicle identification and preventing interference on data access” (see Sekine, Column 1, Lines 41-44).

Art Unit: 3694

22. Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gunnarsson ('222) in view of Sekine ('675) as applied to claim 87 above, and further in view of Swett ('200).

23. Re Claim 94, Gunnarsson in view of Sekine teaches all of the limitations of Parent Claim 87, *supra*. Gunnarsson in view of Sekine does not specifically teach *wherein the appropriate enabling authority is selected from the group consisting of a financial institution, a third-party distributor, and a credit card issuer*. However, Swett teaches a "fast lane credit card" wherein "the instrument [PTD] is a functional authorized credit card/debit card which is issued by banks, or the Turnpike Authority, or a licensed agency" (see at least Column 20, Lines 12-14). Since both Gunnarsson in view of Sekine and Swett relate to mobile devices used to pay for vehicular services and products, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the third party registration/payment linkage of Swett into the vehicular payment system of Gunnarsson in view of Sekine in order to better "negotiate[] monetary funds transfer remotely, in real time, thus allowing toll transaction payments to be made from a moving vehicle without stopping or without slowing down" (see Swett, Column 20, Lines 5-9).

24. Claim 119 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gunnarsson ('222) in view of Swett ('200).

25. Re Claim 119, Gunnarsson teaches the limitations of Parent Claim 112, *supra*. Gunnarsson does not teach *said PTD further being associated with a third party enabling authority, said third party enabling authority is selected from the group*

Art Unit: 3694

consisting of a financial institution, a third-party distributor, and a credit card issuer.

However, Swett teaches a "fast lane credit card" wherein "the instrument [PTD] is a functional authorized credit card/debit card which is issued by banks, or the Turnpike Authority, or a licensed agency" (see at least Column 20, Lines 12-14). Since both Gunnarsson and Swett relate to mobile devices used to pay for vehicular services and products, it would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the third party registration/payment linkage of Swett into the vehicular payment system of Gunnarsson in order to better "negotiate[] monetary funds transfer remotely, in real time, thus allowing toll transaction payments to be made from a moving vehicle without stopping or without slowing down" (see Swett, Column 20, Lines 5-9).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Osborne
Examiner
AU 3694

MS


ELLA COLBERT
PRIMARY EXAMINER